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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/978,215      | 10/15/2001  | Luis J. Rodriguez    |                     | 4475             |

7590

02/28/2002

LUIS J. RODRIGUEZ  
60 FOURTH STREET  
SOUTH ORANGE, NJ 07079

EXAMINER

GARBE, STEPHEN P

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 02/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/978,215

Applicant(s)

RODRIGUEZ, LUIS J. *WR*

Examiner

Stephen P. Garbe

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

Art Unit: 3727

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This disclosure does not enable one of ordinary skill in the art to make and use the invention recited in these claims because the written description and drawings describe and illustrate a form having only two parts: (1) at least one flap and (2) a body. However, these claims require a form having (1) at least one flap, (2) a body, and (3) another portion. Since no other portion is described or illustrated, it is impossible to determine how to make and use the claimed invention based on this disclosure.

In addition, the sealing form, as claimed, cannot perform the function set forth in the last three lines of claims 1 and 17, because there are only two parts to the disclosed form: at least one flap and a body. Thus, if the adhesive is in contact with adhesive inhibitor whenever the flap is in contact with the body, there is no other part of the form which can be used to seal the form because virtually the entire body would need to be covered with either adhesive or adhesive inhibitor. No new matter may be added in response to this rejection.

3. Claims 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

Art Unit: 3727

to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This disclosure does not enable one of ordinary skill in the art to make and use the invention recited in these claims because it does not explain how to simultaneously produce a continuous assembly of forms. The forms in a series of forms are produced one at a time in series, not simultaneously.

4. The drawings are objected to under 37 C.F.R. 1.83(a) as failing to illustrate (1) a form having a flap, a layer of adhesive and a layer of inhibitor such that, whenever the flap is in contact with the body, one layer of adhesive faces one layer of an inhibitor, as recited in claim 1, (2) a form having at least one flap, a body, and another portion, as recited in claim 1, and (3) a multiple ply portion, as recited in claim 13. No new matter may be added.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 and 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The part of claims 1 and 17 which requires that, when the flap is in contact with the body, one layer of adhesive faces one layer of an inhibitor is inconsistent with the part of claims 1 and 17 that requires the positioning of another portion of the form between the body and the flap because the form has no other portion. Thus, it cannot be determined what these claims require. No new matter may be added in response to this rejection.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Schieman, U.S. Patent No. 2,367,440. The embodiment illustrated in Figures 1–4 of Schieman discloses all claimed structural features including a layer of adhesive 3 and a layer of adhesive inhibitor 4. In addition, Figure 2 illustrates an initial bent condition, and Figure 4 illustrates a final bent condition. The phrase “self contained form” does not impart any structure to the claim that is not disclosed by Schieman.

9. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman, U.S. Patent No. 2,367,440. Figure 2 of Schieman discloses all structural features required by this claim. The term “form” does not impart any structure to the claim that is not disclosed by Schieman. The remainder of the claim comprises statements of function and intended use that do not add any structure and do not define over Schieman. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3727

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

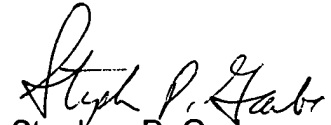
11. Claims 7-9, 11, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., U.S. Patent No. 4,487,360, in view of Schieman, U.S. Patent No. 2,367,440. The embodiment of Figure 9 of Fisher discloses all claimed features except for a layer of adhesive inhibitor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the body of Fisher's form with adhesive inhibitor, as taught by Schieman at 4, so that Fisher's two closure flaps 11 and 32 may be folded so as to bring the adhesive on each flap into contact with the inhibitor because this would prevent premature adhesion of the flaps to the body of the form.

12. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., U.S. Patent No. 4,487,360, in view of Schieman, U.S. Patent No. 2,367,440, as applied to claims 7 and 11, respectively, and further in view of Kehoe, U.S. Patent No. 3,995,808. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a continuous series of Fisher's envelopes, as taught by Kehoe, because a continuous series facilitates printing.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., U.S. Patent No. 4,487,360, in view of Schieman, U.S. Patent No. 2,367,440, as applied to claim 11, and further in view of Johnsen, U.S. Patent No. 3,837,565. It would have been obvious to provide a portion of Fisher's mailer with multiple plies, as taught by Johnsen, because multiple plies provide multiple copies for plural recipients.

Art Unit: 3727

14. The remaining patents are cited to show other mailers having similar features.
15. Any inquiry concerning this application or proceeding should be directed to Stephen Garbe who can be reached at 703-308-1207. The examiner can normally be reached Monday-Thursday between the hours of 7:15 and 4:45 and alternate Fridays between the hours of 7:15 and 3:45.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on 703-308-2572.
17. The fax phone numbers for Technology Center 3700 are 703-872-9302 for papers filed in response to a non-final Office Action and 703-872-9303 for papers filed in response to a Final Office Action.
18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-1148.

  
Stephen P. Garbe  
Primary Examiner  
Group 3720